

REMARKS

The application has been amended and is believed to be in condition for allowance.

The Advisory Action of November 27, 2006 basically states that recitations regarding intended does not differentiate the claimed apparatus from the prior art apparatus satisfying the claimed structural limitations. MPEP 2111.02 was referenced.

The claims have been amended taking MPEP 2111.02 into account. MPEP 2111.02 relates to claim preambles. Note, however, that it is clearly stated that the determination of whether a preamble limits a claim is made on a case-by-case basis in light of the facts in each case, and that there is no litmus test defining when a preamble limits the scope of a claim. *Catalina Mktg. Int'l v. Coolsavings.com, Inc.*, 289 F.3d 801, 808, 62 USPQ2d 1781, 1785 (Fed. Cir. 2002).

"[A] claim preamble has the import that the claim as a whole suggests for it." *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995). "If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). See *Kropa v. Robie*, 187 F.2d 150,

152, 88 USPQ 478, 481 (CCPA 1951) (A preamble reciting "An abrasive article" was deemed essential to point out the invention defined by claims to an article comprising abrasive grains and a hardened binder and the process of making it. The court stated "it is only by that phrase that it can be known that the subject matter defined by the claims is comprised as an abrasive article. Every union of substances capable *inter alia* of use as abrasive grains and a binder is not an 'abrasive article.'" Therefore, the preamble served to further define the structure of the article produced.).

This section of the MPEP further provides guidance that any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation. See, e.g., *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989) (The determination of whether preamble recitations are structural limitations can be resolved only on review of the entirety of the application "to gain an understanding of what the inventors actually invented and intended to encompass by the claim."); *Pac-Tec Inc. v. Amerace Corp.*, 903 F.2d 796, 801, 14 USPQ2d 1871, 1876 (Fed. Cir. 1990) (determining that preamble language that constitutes a structural limitation is actually part of the claimed invention).

See also *In re Stencel*, 828 F.2d 751, 4 USPQ2d 1071 (Fed. Cir. 1987). (The claim at issue was directed to a driver

for setting a joint of a threaded collar*;< however>,< the body of the claim did not directly include the structure of the collar as part of the claimed article. The examiner did not consider the preamble, which did set forth the structure of the collar, as limiting the claim. The court found that the collar structure could not be ignored. While the claim was not directly limited to the collar, the collar structure recited in the preamble did limit the structure of the driver. "[T]he framework - the teachings of the prior art - against which patentability is measured is not all drivers broadly, but drivers suitable for use in combination with this collar, for the claims are so limited." *Id.* at 1073, 828 F.2d at 754.).

This MPEP section also address intended use. Again, the guidance is that the claim preamble must be read in the context of the entire claim. The determination of whether preamble recitations are structural limitations or mere statements of purpose or use "can be resolved only on review of the entirety of the [record] to gain an understanding of what the inventors actually invented and intended to encompass by the claim." *Corning Glass Works*, 868 F.2d at 1257, 9 USPQ2d at 1966. If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not

considered a limitation and is of no significance to claim construction. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999).

Consider *Jansen v. Rexall Sundown, Inc.*, 342 F.3d 1329, 1333-34, 68 USPQ2d 1154, 1158 (Fed. Cir. 2003) (In a claim directed to a method of treating or preventing pernicious anemia in humans by administering a certain vitamin preparation to "a human in need thereof," the court held that the preamble is not merely a statement of effect that may or may not be desired or appreciated, but rather is a statement of the intentional purpose for which the method must be performed. Thus the claim is properly interpreted to mean that the vitamin preparation must be administered to a human with a recognized need to treat or prevent pernicious anemia.); *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1346-48, 64 USPQ2d 1202, 1204-05 (Fed. Cir. 2002) (A claim at issue was directed to a method of preparing a food rich in glucosinolates wherein cruciferous sprouts are harvested prior to the 2-leaf stage. The court held that the preamble phrase "rich in glucosinolates" helps define the claimed invention, as evidenced by the specification and prosecution history, and thus is a limitation of the claim (although the claim was anticipated by prior art that produced sprouts inherently "rich in glucosinolates")).

See that this section of the MPEP requires that during examination, statements in the preamble reciting the purpose or

intended use of the claimed invention must be evaluated to determine whether the recited purpose or intended use results in a structural difference ... between the claimed invention and the prior art. If so, the recitation serves to limit the claim. See, e.g., *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963) (The claims were directed to a core member for hair curlers and a process of making a core member for hair curlers. Court held that the intended use of hair curling was of no significance to the structure and process of making.); *In re Sinex*, 309 F.2d 488, 492, 135 USPQ 302, 305 (CCPA 1962) (statement of intended use in an apparatus claim did not distinguish over the prior art apparatus). If a prior art structure is capable of performing the intended use as recited in the preamble, then it meets the claim.

However, a "preamble may provide context for claim construction, particularly, where ... that preamble's statement of intended use forms the basis for distinguishing the prior art in the patent's prosecution history." *Metabolite Labs., Inc. v. Corp. of Am. Holdings*, 370 F.3d 1354, 1358-62, 71 USPQ2d 1081, 1084-87 (Fed. Cir. 2004). See also *Catalina Mktg. Int'l v. Coolsavings.com, Inc.*, 289 F.3d at 808-09, 62 USPQ2d at 1785 ("[C]lear reliance on the preamble during prosecution to distinguish the claimed invention from the prior art transforms the preamble into a claim limitation because such reliance indicates use of the preamble to define, in part, the claimed invention...Without such reliance, however, a preamble generally

is not limiting when the claim body describes a structurally complete invention such that deletion of the preamble phrase does not affect the structure or steps of the claimed invention."

Applicants note that the recitations previously relied upon were not exclusively found in the preambles. This functional language gives weight to the explicit claim recitations and must be given patentable weight.

In order to advance the case, however, the claims have been amended and new claims added. The new claims read on the elected species.

In this regard, see that the very beginning of the specification sets out that "The present invention relates to a box for a set of electric storage batteries, particularly for an electric self-propelled vehicle, such as a maintenance machine and is particularly suitable for receiving batteries consisting of sealed elements of the gas recombination type" (emphasis added).

From specification page 3, "It is intended to receive a set of electric storage batteries, particularly sealed elements of the gas-recombination type, and to be placed in a housing provided for this purpose in a vehicle so as to serve as a source of electric motive power."

Claim 9 has been amended to recite that the batteries are electric self-propelled vehicle batteries having gas recombination sealed elements and serving as a source of electric

motive power for the vehicle, each floor support is sized and constructed to support the electric self-propelled vehicle batteries having gas recombination sealed elements batteries stored therebetween.

See the last recitation that each floor support is sized and constructed to support batteries that are electric self-propelled vehicle batteries having gas recombination sealed elements and sized for serving as a source of electric motive power for a vehicle. The new claims include similar recitations.

These new recitations are not merely reciting the purpose or intended use of the claimed invention, but rather a specific requirement that results in a structural difference ... between the claimed invention and the prior art. Thus, the recitation serves to limit the claim. See, above, *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963). Further, the applied prior art does is not capable of satisfying these new recitations. Thus, the claims are patentable over the prior art.

Additionally, in view of the present application's prosecution history, it is clear what subject matter the inventors are claiming, and this forms a further basis for distinguishing over the prior art.

Claims 9-11, 13, 14, and 16 were rejected as anticipated by WHITAKER 2,172,266.

The dependent claims are believed allowable at least for depending from an allowable claim.

WHITAKER does not anticipate. WHITAKER does not disclose a box for a set of electric storage batteries (claim 9) having the recited structural features.

The WHITAKER walls do not themselves directly stack. See the new dependent claims.

WHITAKER does not disclose comprising at least two side walls (12, 14) extending parallel and defining between themselves a housing for receiving the batteries, wherein, the pair of wall elements (18, 20) are two horizontally opposed wall elements (18, 20) together forming a floor support for the batteries stored therebetween, and each of the two horizontally opposed wall elements form a floor support for one edge of each battery stored therebetween. The claims have been amended to explicitly recite this structural requirements, where the type of battery being supported is recited.

Further, WHITAKER does not disclose that the two horizontally opposed wall elements are separated from each other by an intervening air space so that the two horizontally opposed wall elements support each battery by opposite base edges of the battery with a base area of the battery between the opposite edges unsupported and exposed to the intervening air space.

Therefore, this rejection should be withdrawn.

Claims 9-11 were rejected as obvious over TOYOSAWA 5,056,677.

TOYOSAWA discloses a small article holder adapted to hold or support a small article such as a wrapping film case, a booklet or a kitchen gadget. TOYOSAWA discloses a holder which comprises a pair of holder bodies, each holder body having a supporting section for supporting a small article to be held, and means for securing the holder bodies to a fixed structure such as refrigerator located in a kitchen area, said securing means being fixed to the back surface of each of the holder bodies.

However, TOYOSAWA does not disclose a box for a set of electric storage batteries of the type recited. TOYOSAWA does not disclose comprising at least two side walls (12, 14) extending parallel and defining between themselves a housing for receiving the batteries, wherein, the pair of wall elements (18, 20) are two horizontally opposed wall elements (18, 20) together forming a floor support for the batteries stored therebetween, and each of the two horizontally opposed wall elements form a floor support for one edge of each battery stored therebetween.

Further, TOYOSAWA does not disclose that the two horizontally opposed wall elements are separated from each other by an intervening air space so that the two horizontally opposed wall elements support each battery by opposite base edges of the battery with a base area of the battery between the opposite edges unsupported and exposed to the intervening air space.

The stacking of multiple boxes for storing batteries is not believed obvious, taking into account the nature of batteries

and necessary care therefor. The Official Action provides insufficient basis for judging such stacking obvious.

See that the elements are closed on all their front vertical sides. Consequently, the articles must be inserted vertically into the elements. Stacking the elements would, so, make it impossible to insert or extract a battery, except into or from the uppermost element.

In contrast, in the invention, due to the absence of a fixed front vertical wall, horizontal insertion/extraction of a battery is possible at any level of the stack without any need to remove the elements of the upper levels. See the new claims, e.g., claim 29.

The obviousness rejection is not viable. Therefore, this rejection should also be withdrawn.

Claims 9-16 were rejected as obvious over SCHAEFER 2,916,161 in view of either one of BECKLEY 5,441,123 and IDO 6,326,103.

SCHAEFER does not disclose a pair of wall elements with two horizontally opposed wall elements (18, 20) together forming a floor support for any battery stored therebetween, each of the two horizontally opposed wall elements forming a floor support for one edge of each battery stored therebetween, wherein the two horizontally opposed wall elements are separated from each other by an intervening air space. See Figures 1-2 of the application.

The reference does not teach this structure, due to at least the single floor element 6.

See also that there is no disclosure of two horizontally opposed wall elements that support each battery by opposite edges of the battery with an area of the battery between the opposite edges being exposed to the intervening air space.

SCHAEFER has a classical single floor element which constitutes a full bottom of the container, and is acknowledged by the Official Action not to teach a space between the walls such that a base area of the battery is unsupported and exposed.

BECKLEY and IDO are each offered for vent holes. Note that in BECKLEY, the ventilation holes are on the top wall of the box.

At best, these references would only teach to drill holes in the bottom of SCHAEFER, and the recited structure would not result with the bottom being mere angled edges on which boxes or batteries could rest. To suggest that the combination would teach more is mere and pure hindsight.

These rejections should also be withdrawn.

Reconsideration and allowance of the examined claims are respectfully requested.

Examination of the withdrawn claims is requested as these claims have previously been examined and are drawn to a battery box with sidewalls and an open space between the walls.

Applicants thus believe that the present application is in condition for allowance and an early indication of the same is respectfully requested.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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